APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,191	01/30/2004	Anthony Bruce	APRE0003	5717

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EXAMINER
ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/767,191	BRUCE ET AL.
	Examiner	Art Unit
	FOLASHADE ANDERSON	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 February 2009</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-42</u> is/are pending in the application.
   4a) Of the above claim(s) <u>1-23 and 40-42</u> is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>24-39</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>30 January 2004</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some *   c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This is the first non-final office action in response to Applicant's submission filed

on February 12, 2009. Currently, claims 1-42 are pending. Claims 1-23 and 40-42 are

withdrawn from consideration.

Election/Restrictions

2.   Applicant's election of group III (claims 24-39) in the reply filed on February 12,

2009 is acknowledged. Because applicant did not distinctly and specifically point out

the supposed errors in the restriction requirement, the election has been treated as an

election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on March 22, 2005 was

considered by the Examiner in the prosecution of the claims in the instant application.

Drawings

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: specifically in paragraph 044 indicates that the engine of figure 1 should be

marked with signal 140. Corrected drawing sheets in compliance with 37 CFR 1.121(d)

are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

5.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because reference character "138" of figure 1 has been used to designate both

database and engine. Corrected drawing sheets in compliance with 37 CFR 1.121(d)

are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

Claim Objections

6.   Claim 26 objected to because of the following informalities: The ending

punctuation of a semicolon ";" indicates that there is more to the claim; however the use

of "and" in joining the two limitations of the claim indicates Applicant only intended two

limitations in the claim. For purposes of examination the Examiner assumes Applicant

only intended to claim the two limitations. Appropriate correction is required.

7.   Claim 38 objected to because of the following informalities: the use of "fiom",

which appears to be a typographical error. For purposed of examination the Examiner

assumes Applicant intended "from".

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   Claim 33-39 rejected under 35 U.S.C. 101 because independent claim 33 is

directed to non-statutory subject matter. The claim is presented as a system claim

without hardware elements. As such the claim must be give its broadest reasonable

interpretation in light of the specification, and is being interpreted as software. Support

for this interpretation may be found in paragraph 041 and figure 1 of the specification.

Software alone does not qualify as a patentable statutory class, see MPEP 2106.01.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 24-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harhen (US Patent 5,406,477) in view of Honarvar (US Patent 6,321,206 B1).

<u>Claims 24 and 33</u>

Harhen teaches a method for analyzing a business initiative for a business network

including business locations including test sites that have implemented the business

initiative during a predetermined test period and non-test group sites that have not

implemented the initiative, each of the sites being associated with a set of attributes, the method comprising:

- receiving, from a server, a list of the attributes ranked based on each attribute's impact on performance values associated with the test sites during the test period **(Harhen col. 5, lines 4-7 and col. 8, lines 17-20)**;

- configuring a model to predict the performance value of the sites based on the ranked list of attributes **(Harhen col. 8, lines 63-68)**;

- instructing the server to execute the model for the test sites **(Harhen col. 14, lines 59-68)**

- receiving results of the executed model, wherein the results include quantitative measures of the model's ability to accurately predict the performance levels of the test sites **(Harhen col. 41, lines 15-20)**;

Harhen does not expressly teach:

- instructing the server to apply the model to the non-test group sites to predict the performance levels of the non-test group sites based on a determination that the model accurately predicts the performance levels of the test sites; and

- receiving a list of non-test group sites ranked based on each non-test group site's predicted performance level.

Honarvar teaches

- instructing the server to apply the model to the non-test group sites to predict the performance levels of the non-test group sites based on a determination that the

model accurately predicts the performance levels of the test sites (**Honarvar col. 5, lines 37-40 and col. 6 , lines 26-29)**; and

- receiving a list of non-test group sites ranked based on each non-test group site's predicted performance level **(Honarvar col.8, lines 62-67)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Honarvar since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 33 which is the system for implementing the method of claim 24 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 25 and 34

Harhen and Honarvar teach all the features of claim 24 and Honarvar further teaches selecting a subset of the non-test group sites to implement the business initiative based on the ranked list of those sites (**Honarvar col. 13, lines 23-28)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Honarvar since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 34 which is the system for implementing the method of claim 25 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 26

Harhen and Honarvar teach all the features of claim 24 and Harhen further teaches selecting the model from a list of models provided by the server; and selecting one or more parameters for the selected model **(Harhen col. 20, line 24 and col. 37, lines 7-15)**;

Claim 27 and 39

Harhen and Honarvar teach all the features of claim 24 and Harhen further teaches reconfiguring the model with at least one new parameter based on a determination that the model does not accurately predict the performance levels of the test sites **(Harhen col. 18, lines 40-43)**; and instructing the server to execute the reconfigured model for the test sites. **(Harhen col. 6, lines 44-63).**

With respect to claim 39 which is the system for implementing the method of claim 27 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 28 and 38

Harhen and Honarvar teach all the features of claim 27 and Harhen further teaches repeating the reconfiguring and executing the reconfigured model until the quantitative measure reflect that the model accurately predicts the performance levels of the test sites **(Harhen col. 6, lines 44-63)**.

With respect to claim 38 which is the system for implementing the method of claim 28 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 29 and 37.

Harhen and Honarvar teach all the features of claim 24 and Harhen further teaches selecting a number of the ranked attributes that the model should consider when executing (**Harhen col. 5, lines 4-7 and col. 8, lines 17-20**).

With respect to claim 37 which is the system for implementing the method of claim 29 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 30.

Harhen and Honarvar teach all the features of claim 24 and Harhen further teaches wherein the quantitative measures includes a ranked list of selected attributes that the model considered during its execution and data values assigned to each of the selected attributes by the model **(Harhen col. 17, lines 23-27)**.

Claim 31.

Harhen and Honarvar teach all the features of claim 30 and Harhen further teaches, wherein the data values includes a coefficient data value for a mathematical function used by the model to generate the results **(Harhen col. 17, lines 5-15)**.

Claim 32 and 36

Harhen and Honarvar teach all the features of claim 24 and Harhen further teaches wherein the list of the attributes ranked based on each attribute's impact on the test site **(Harhen col. 17, lines 23-27)**.

Harhen does not teach; however, Honarvar does teach, wherein the non-test group sites includes a set of control group sites and performance values is generated by the server based on comparisons between test site fragments and corresponding control group site fragments, wherein each fragment is generated by the server based on each respective site's attribute value and performance value **(Honarvar col. 5, lines 37-40 and col. 6 , lines 26-29)**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Honarvar since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 36 which is the system for implementing the method of claim 32 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 35

Harhen and Honarvar teach all the features of claim 34 however neither teaches where in the user operates a client remotely located from the system.

Official notice is taken that it was old and well known in the art at the time the invention was made to allow a user to remote access to a system for operating purposes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen and Honarvar the very old and well known feature of in the user operates a client remotely located from the system since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Avery et al (Adding bricks to clicks: the contingencies driving cannibalization and complementarily in multichannel retailing, 02/2009) teaches weighing the options of various retail locations.

        Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is

(571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623